

### **REMARKS**

The Official Action mailed August 23, 2006, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on April 9, 2004; April 22, 2004; and August 29, 2005.

Claims 33-42 and 45-63 were pending in the present application prior to the above amendment. Dependent claim 42 has been canceled without prejudice or disclaimer. Claims 33, 34, 39-41, 45, 46, 48-54, 58, 59, 62 and 63 have been amended to better recite the features of the present invention. New dependent claims 64-67 have been added to recite additional protection to which the Applicant is entitled. Accordingly, claims 33-41 and 45-67 are now pending in the present application, of which claims 33, 34, 41 and 50-52 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 33, 34, 37-42, 45-47, 49-52, 54, 55, 57-59 and 61-63 as anticipated by U.S. Patent No. 6,737,306 to Yamazaki. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 33 has been amended to recite a first element-forming region and a second element-forming region which each include a gate electrode that is used as a mask to form an impurity region. Claim 33 also recites that a scanning direction of the

energy beam changes outside and between the first element-forming region and the second element-forming region.

Claim 34 has been similarly amended to claim 33 and further recites that the energy beam starts or ends irradiation from outside the first element-forming region and the second element-forming region, as well as changing a scanning direction between the first element-forming region and the second element-forming region.

Claims 51 and 52 recite forming a crystalline semiconductor film by irradiating an energy beam output continuously while scanning the energy beam to a semiconductor film by moving the semiconductor film and the energy beam relatively, but are otherwise similar to claims 33 and 34, respectively.

The Applicant respectfully submits that Yamazaki '306 does not teach the above-referenced features of amended independent claims 33, 34, 51 and 52 of the present invention, either explicitly or inherently. Specifically, for example, Yamazaki '306 does not teach that the direction of the energy beam changes between a first element-forming region and a second element-forming region.

Claims 41 and 50 are directed to a method for manufacturing a semiconductor device. Claim 41 includes steps of forming a first circuit and a second circuit, and has been amended to recite that the energy beam is irradiated outside and between the first circuit and the second circuit while changing a scanning direction of the energy beam. Claim 50 also includes the steps of forming a first circuit and a second circuit and has been amended to recite that the energy beam starts or ends irradiation from outside the first circuit and the second circuit and a scanning direction of the energy beam changes between the first circuit and the second circuit.

The Official Action asserts that Yamazaki '306 teaches a first circuit 202, a second circuit 205 and that "the semiconductor device is irradiated to a region between the first circuit and the second circuit while changing the scanning direction of the energy beam" (page 4, Paper No. 20060809). The Official Action cites Figure 14 and column 7, lines 59-65, in support of the assertion (Id.). However, Yamazaki '306 does

not teach the features of amended claims 41 and 50. Specifically, Yamazaki '306 does not teach that the energy beam is irradiated outside and between the first circuit 202 and the second circuit 205 while changing a scanning direction of the energy beam or that the energy beam starts or ends irradiation from outside the first circuit 202 and the second circuit 205 and a scanning direction of the energy beam changes between the first circuit 201 and the second circuit 205, either explicitly or inherently (see, e.g., Figures 6 and 7 with respect to Figure 14; and column 7, lines 59-65).

Also, dependent claims 39, 40, 58 and 52 have been amended to better recite the features of the present invention. The features of amended claims 39, 40, 58 and 52 are supported in the present specification, for example, by paragraph [0016] of the *Substitute Specification* filed April 22, 2004, or paragraph [0024] of the pre-grant publication of the present application, which is U.S. Patent Application Publication No. 2005/0037552.

Since Yamazaki '306 does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 35, 36, 48, 53, 56 and 60 as obvious based on the combination of Yamazaki '306 and U.S. Patent No. 4,439,245 to Wu. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the

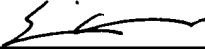
teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Yamazaki '306. Wu does not cure the deficiencies in Yamazaki '306. The Official Action relies on Wu to allegedly teach the features of some of the dependent claims. Specifically, the Official Action relies on Wu to allegedly teach use of a galvanometer mirror or a polygon mirror. However, Yamazaki '306 and Wu, either alone or in combination, do not teach or suggest that the direction of the energy beam changes between a first element-forming region and a second element-forming region or between a first circuit and a second circuit. Since Yamazaki '306 and Wu do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 64-67 have been added to recite additional protection to which the Applicant is entitled. The features of claims 64-67 are supported in the present specification, for example, by paragraph [0016] of the *Substitute Specification* filed April 22, 2004, or paragraph [0024] of the pre-grant publication of the present application, which is U.S. Patent Application Publication No. 2005/0037552. For the reasons stated above and already of record, the Applicant respectfully submits that new claims 64-67 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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